

Notice of Allowability

Application No.

10/089,796

Examiner

Konata M. George

Applicant(s)

BOLOGNA ET AL.

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Amendment filed May 26, 2004.
2. ☒ The allowed claim(s) is/are 13-22 and 38-50 (renumbered 1-23).
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Claims 13-22 and 38-50 are pending in this application.

Action Summary

1. Examiner acknowledges the cancellation of claims 1-10, 36 and 37. Therefore, any and all rejections directed towards these claims are hereby withdrawn.
2. Examiner acknowledges the addition of claims 39-50.
3. The rejection of claims 13-22 under 35 U.S.C 112, 1st paragraph as being ~~unenab~~^{NPN -}led is hereby withdrawn as applicant has removed the ~~unenabling~~^{NPN -} language. ✓
4. The rejection of claims 13-19 and 22 under 35 U.S.C. 102(e) as being anticipated by Harrison et al. as evidenced by Peterson et al. is hereby withdrawn in response to applicants arguments.
5. The rejection of claim 38 under 35 U.S.C. 102(e) as being anticipated by Harrison et al. as evidenced by Peterson et al. is hereby withdrawn as it was improperly applied.
6. The rejection of claims 20 and 21 under 35 U.S.C. 103(a) as being anticipated by Harrison et al. in view of Peterson et al. is hereby withdrawn in response to applicants arguments.

Statement of Reasons for Allowance

7. The following is an examiner's statement of reasons for allowance:

The claims are allowable over the cited prior art because the prior art does not teach, disclose nor make obvious a method of treating endometriosis by administering a composition comprising a β -adrenergic agonist and a pharmaceutically acceptable bioadhesive carrier. The closest prior art is Harrison et al. (6,197,327) and Peterson et al. (6,207,696). Together both patents teach a composition comprising β -adrenergic agonists and biocompatible excipients for the treatment of dysmenorrhea.

Dysmenorrhea is defined as the pain associated with endometriosis. Endometriosis is a condition that is characterized by the presence of functioning ectopic endometrial glands and stroma outside the uterine cavity. Therefore, the prior art does not teach not treating the condition of endometriosis, but treating the pain associated with endometriosis.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

8. Claims 13-22 and 38-50 are allowed.

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Telephone Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is (571) 272-0613. The examiner can normally be reached from 8AM to 5:30PM Monday to Thursday, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Konata M. George


GARY KUNZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600